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TECHNOLOGY CENTER 3600

In re Application of	:	
Robert A. Ferstenberg et al.	:	DECISION ON PETITION UNDER
Application No. 09/209,815	:	37 C.F.R. 1.181(a) TO WITHDRAW
Filed: December 11, 1998	:	THE OBJECTION TO CLAIMS
For: COMPUTER METHOD AND	:	UNDER 37 CFR 1.75(c)
SYSTEM FOR INTERMEDIATED	:	
EXCHANGE OF COMMODITIES	:	

This is a decision on the petition under 37 CFR 1.181(a) filed November 18, 2004, for withdrawal of the objection to claims 127, 128, 139, 146, and 147 under 37 CFR 1.75(c) in the Office action mailed November 12, 2004.

Petitioner alleges that the objection to claims 127, 128, 139, 146, and 147 under 37 CFR 1.75(c) as being of improper dependent form is improper.

MPEP 608.01(n)(II) states in part that "Any claim which is in dependent form but which is so worded that it, in fact is not, as, for example, it does not include every limitation of the claim on which it depends, will be required to be canceled as not being a proper dependent claim; and cancellation of any further claim depending on such a dependent claim will be similarly required. Where a claim in dependent form is not considered to be a proper dependent claim under 37 CFR 1.75(c), the examiner should object to such claim under 37 CFR 1.75(c) and require cancellation of such improper dependent claim or rewriting of such improper dependent claim in independent form. See *Ex parte Porter*, 25 USPQ2d 1144, 1147 (Bd. of Pat. App. & Inter. 1992) (A claim determined to be an improper dependent claim should be treated as a formal matter, in that the claim should be objected to and applicant should be required to cancel the claim (or replace the improper dependent claim with an independent claim) rather than treated by a rejection of the claim under 35 U.S.C. 112, fourth paragraph.). The applicant may thereupon amend the claims to place them in proper dependent form, or may redraft them as independent claims, upon payment of any necessary additional fee."

MPEP 608.01(n)(III) sets forth the "Infringement Test" used in making this determination. "The test as to whether a claim is a proper dependent claim is that it shall include every limitation of the claim from which it depends (35 U.S.C. 112, fourth paragraph) or in other words that it shall not conceivably be infringed by anything which would not also infringe the basic claim. A dependent

claim does not lack compliance with 35 U.S.C. 112, fourth paragraph, simply because there is a question as to (1) the significance of the further limitation added by the dependent claim, or (2) whether the further limitation in fact changes the scope of the dependent claim from that of the claim from which it depends. The test for a proper dependent claim under the fourth paragraph of 35 U.S.C. 112 is whether the dependent claim includes every limitation of the claim from which it depends. The test is not one of whether the claims differ in scope. Thus, for example, if claim 1 recites the combination of elements A, B, C, and D, a claim reciting the structure of claim 1 in which D was omitted or replaced by E would not be a proper dependent claim, even though it placed further limitations on the remaining elements or added still other elements. Examiners are reminded that a dependent claim is directed to a combination including everything recited in the base claim and what is recited in the dependent claim. It is this combination that must be compared with the prior art, exactly as if it were presented as one independent claim. The fact that a dependent claim which is otherwise proper might relate to a separate invention which would require a separate search or be separately classified from the claim on which it depends would not render it an improper dependent claim, although it might result in a requirement for restriction. The fact that the independent and dependent claims are in different statutory classes does not, in itself, render the latter improper. Thus, if claim 1 recites a specific product, a claim for the method of making the product of claim 1 in a particular manner would be a proper dependent claim since it could not be infringed without infringing claim 1. Similarly, if claim 1 recites a method of making a product, a claim for a product made by the method of claim 1 could be a proper dependent claim. On the other hand, if claim 1 recites a method of making a specified product, a claim to the product set forth in claim 1 would not be a proper dependent claim since it is conceivable that the product claim can be infringed without infringing the base method claim if the product can be made by a method other than that recited in the base method claim.”

Another way to think of it is - if you can infringe the dependent claim without infringing the independent claim, then the dependent claim is an improper dependent claim because it does not require all the limitations of the independent claim. Analyzing the claims objected to by the Examiner, one sees that they all fail this “infringement test.”

Independent claims 116, 129 and 140 each claim “a computer implemented method” and goes on to recite the steps performed by the method as claim limitations.

Claim 127 recites a “computer system” and includes a limitation that “one or more memories accessible by the processors and storing program instructions for causing the processors to perform the method of claim 116.” Applying the infringement test, what is needed to infringe claim 127 is, for example, a computer having one or more processors, one or more links, and one or more memories containing program instructions that if and when executed would cause the computer to do the generating electronic opening messages, generating electronic offer messages, generating electronic counter-offer messages, and repeating steps. However, such a computer would **not** infringe the method steps of claim 116 since the computer itself never performs any of the active steps of generating electronic opening messages, generating electronic offer messages, generating electronic counter-offer messages, and repeating required by the method. In other words, mere possession of such a computer would infringe claim 127, but this is not enough to infringe claim 116. As a result, claim 127 is an improper dependent claim.

Claim 128 recites a “computer readable medium having stored therein encoded computer-executable instructions for causing a computer to perform the method of claim 116”. Applying the infringement test, what is needed to infringe claim 128 is, for example, a CD-ROM having computer executable

instructions that if and when executed would cause a computer to do the generating electronic opening messages, generating electronic offer messages, generating electronic counter-offer messages, and repeating steps. However, such a CD-ROM would **not** infringe the method steps of claim 116 since the CD-ROM itself never performs any of the active steps of generating electronic opening messages, generating electronic offer messages, generating electronic counter-offer messages, and repeating required by the method. In other words, mere possession of such a CD-ROM would infringe claim 128, but this is not enough to infringe claim 116. As a result, claim 128 is an improper dependent claim.

Claim 139 recites a “computer readable medium having stored therein encoded computer-executable instructions for causing a computer to perform the method of claim 129”. Applying the infringement test, what is needed to infringe claim 139 is, for example, a CD-ROM having computer executable instructions that if and when executed would cause a computer to do the receiving from participants electronic opening messages and electronic counter-offer messages, generating electronic offer messages, and repeating steps. However, such a CD-ROM would **not** infringe the method steps of claim 129 since the CD-ROM itself never performs any of the active steps of receiving from participants electronic opening messages and electronic counter-offer messages, generating electronic offer messages, and repeating required by the method. In other words, mere possession of such a CD-ROM would infringe claim 139, but this is not enough to infringe claim 129. As a result, claim 139 is an improper dependent claim.

Claim 146 recites a “computer system” and includes a limitation of “a memory accessible by the processor and storing program instructions for causing the processor to perform the method of claim 140. Applying the infringement test, what is needed to infringe claim 146 is, for example, a computer having a processor and a memory containing program instructions that if and when executed would cause the computer to do the generating an electronic opening message, receiving an electronic offer message, and generating one or more electronic counter-offer messages steps. However, such a computer would **not** infringe the method steps of claim 140 since the computer itself never performs any of the active steps of generating an electronic opening message, receiving an electronic offer message, and generating one or more electronic counter-offer messages required by the method. In other words, mere possession of such a computer would infringe claim 146, but this is not enough to infringe claim 140. As a result, claim 146 is an improper dependent claim.

Claim 147 recites a “computer readable medium having stored therein encoded computer-executable instructions for causing a computer to perform the method of claim 140”. Applying the infringement test, what is needed to infringe claim 147 is, for example, a CD-ROM having computer executable instructions that if and when executed would cause a computer to do the generating an electronic opening message, receiving an electronic offer message, and generating one or more electronic counter-offer messages steps. However, such a CD-ROM would **not** infringe the method steps of claim 140 since the CD-ROM itself never performs any of the active steps of generating an electronic opening message, receiving an electronic offer message, and generating one or more electronic counter-offer messages required by the method. In other words, mere possession of such a CD-ROM would infringe claim 147, but this is not enough to infringe claim 140. As a result, claim 147 is an improper dependent claim.

The Examiner’s objection of claims 127, 128, 139, 140, and 147 under 37 CFR 1.75(c) as being of improper dependent from is correct and consistent with Office policy and practice. Accordingly, the Petition is **DENIED**.

If the petitioner desires further review of the Director's Decision, applicant should consider filing a Petition for Review of the Director's Decision under 37 CFR §1.181(a)(3).

Summary: *Petition Denied*



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